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09/696,762	10/25/2000	Mark Hoffman	UPM-001.01	3125

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EXAMINER

NGUYEN, NGA B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/696,762

Applicant(s)

HOFFMAN ET AL.

Examiner

Nga B. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11, 15-18, 31, 34, 35, 37-39, 46, 49, 51-54 and 56-73 is/are pending in the application.
- 4a) Of the above claim(s) 31, 34, 35 and 37-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11, 15-18, 46, 49, 51-54 and 56-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/27/01; 2/14/02</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is the answer to the Election filed on April 26, 2004, which paper has been placed of record in the file.
2. Claims 11, 15-18, 46, 49, 51-54, and 56-72 are elected for consideration.

### ***Specification***

3. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (see page 10, line 5). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11, 15-18, 46, 49, 51-54, 56, 58, 60, 65, 66, 69, 71, and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by Wallman, U.S. Patent No. 6,601,044.

Regarding to claim 11, Wallman discloses a computer-implemented method for providing investment advice to a client over a computer network, the method comprising:

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providing a database maintaining portfolio information for a plurality of securities portfolios (figure 16 and column 39, line 47-column 40, line 15; general securities portfolio database 165 or securities portfolio database 169);

providing a server computer operably coupled to the database and accessible via client computers to a plurality of clients (figure 6 and column 28, lines 10-38; web server 14, investors' computers 11a-11e connected to web server 14), the server computer including:

an asset allocator operative to receive a request (column 23, lines 21-60; the asset allocation model 1);

a ranker component in communication with the asset allocator (figure 13, items 53a, 55a-55h, 54a, 56a-56h, and column 37, line 58-column 38, line 26; risk ranking and differential return ranking);

a security analyst component in communication with the asset allocator (column 24, lines 1-25);

a portfolio component in communication with the asset allocator (figure 16 and column 39, lines 47-55; portfolio characteristics database 165); and

managing a securities portfolio identified by the database for a client by:

receiving portfolio information (column 23, lines 21-40; receiving the investor's risk tolerance, financial goals, preferred risk-return characteristics, preferences for various types of securities and preferred portfolio mix, etc);

using a ranker component to pass a get benchmark request to the portfolio component (column 24, lines 1-25);

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using a ranker component to pass a get security ranking request to a security analyst component (column 25, line 18-column 26, line 27; the system provides the list of stocks that match the investor's criterion);

determining risk ranking for relevant securities using portfolio minus benchmark weights (figure 5; figure 13 and column 32, lines 58-67; determining risk ranking relative to the benchmark weights S&P 500 or another index);

determining combined ranking for relevant securities based at least in part on risk ranking and on security forecast ranking (figure 13, items 53a, 55a-55h, 54a, 56a-56h, and column 37, line 58-column 38, line 26; risk ranking and differential return ranking; column 16, lines 37-55; column 30, lines 32-60; column 40, lines 40-50; security forecast ranking); and

generating an order list based on the combined ranking (figure 13).

Regarding to claim 15, Wallman discloses wherein the portfolio information maintained by the database includes tax lot information (column 20, lines 42-52).

Regarding to claim 16, Wallman discloses wherein managing a securities portfolio includes: requesting tax lot information from the database for the portfolio (column 34, lines 15-38), and proposing securities transactions to the client based at least in part on the tax lot information for the securities portfolio (column 34, lines 51-60).

Regarding to claim 17, Wallman discloses wherein providing a server comprises: providing a server including a broker connection aggregator; and wherein managing a securities portfolio further comprises: invoking the broker connection

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aggregator to providing a connection to a plurality of brokers over a computer network and to allowing a client to execute securities transactions, through the broker connection, for securities portfolios identified by the database (figure 10, item 50 or figure 14, third party trading system 67; column 41, lines 54-60) .

Regarding to claim 18, Wallman discloses wherein providing a server further comprises: providing a server including a portfolio tracker; and wherein managing a securities portfolio further comprises invoking the portfolio tracker to receive portfolio information for a securities portfolio from a client and to store the portfolio information for the securities portfolio in the database (column 39, line 35-column 40, line 15).

Regarding to claim 46, Wallman discloses a computer data signal embodied in a carrier wave, the computer data signal being transferred between an investment advice server and a user's client computer, the computer data signal comprising:

portfolio information associated with a user's investment portfolio (column 39, lines 47-55; portfolio characteristics database 165);

benchmark information associated with the user's investment portfolio (column 23, lines 21-40; receiving the investor's risk tolerance, financial goals, preferred risk-return characteristics, preferences for various types of securities and preferred portfolio mix, etc);

risk ranking information (figure 5; figure 13; column 38, lines 15-36; risk ranking relative to the S&P 500);

stock rating information (column 40, lines 39-50; providing to the investor the top stocks or the Dow 500 and the Fortune 500);

instructions for a client's browser to display:

a trade station display including a mechanism operative to receive at least one trade request (column 34, lines 38-50; receiving a sell request from the investor);

a holding display operative to depict a relationship between the portfolio information and the benchmark information (column 32, line 30-column 33, line 20);

an analysis display including a current and a projected risk ranking, and stock rating (figures 5, 13, items 53a, 55a-55h, 54a, 56a-56h, and column 37, line 58-column 38, line 26; risk ranking and differential return ranking; column 16, lines 37-55; column 30, lines 32-60; column 40, lines 40-50; stock rating); and

instructions for the client's browser to transmit to an investment advice server the trade request submission a trade request by a user (column 34, lines 38-50; receiving a sell request from the investor).

Regarding to claim 49, Wallman discloses the carrier wave further comprises: portfolio recommendations for the user's investment portfolio; instructions for the client's browser to display a portfolio recommendations display, the portfolio recommendations based at least in part on the portfolio information and the benchmark information (column 30, lines 32-65 and column 31, lines 15-50).

Regarding to claim 51, Wallman discloses a system for providing investment advice, the system comprising:

a database identifying a plurality of securities portfolios and maintaining portfolio information associated with the security portfolios (figure 16 and column 39, line 47-

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column 40, line 15; general securities portfolio database 165 or securities portfolio database 169); and

a server computer operably coupled to the database and accessible via client computers to a plurality of clients (figure 6 and column 28, lines 10-38; web server 14, investors' computers 11a-11e connected to web server 14), the server computer including: a trade advisor component operative to receive from the database portfolio information for a securities portfolio of the client (column 39, line 47-column 40, line 15), the trade advisor component proposing securities transactions based on a combined ranking of a return ranking and a risk ranking for each tradable security available to the client (column 34, lines 15-50), the return ranking being based on an aggregation of normalized securities rankings from one or more analysts for each tradable security (column 30, lines 32-60; column 40, lines 40-50; security forecast ranking), the risk ranking being based on a normalized marginal contribution to risk of each security to the portfolio, the normalized marginal contribution to risk having been scaled by a factor reflecting a client's risk aversion (figure 5; figure 13 and column 32, lines 58-67; risk ranking relative to the benchmark weights S&P 500 or another index)

Regarding to claim 52, Wallman discloses wherein the portfolio information maintained by the database includes tax lot information for the securities included in the portfolios identified by the database (column 20, lines 42-52).

Regarding to claim 53, Wallman discloses wherein the combined ranking is further based on a tax ranking for securities in the portfolio, the tax ranking for each security being based on a normalized and scaled marginal tax gain or marginal tax loss



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resulting from the sale of the security as a percentage of the current price of the security (column 34, lines 15-35).

Regarding to claim 54, Wallman discloses wherein the server further includes graphical user interface generation means for providing a user interface, the user interface includes a client proposed transaction input control whereby a client can input a proposed transaction for a portfolio identified by the investment advice service (column 36, lines 48-65).

Regarding to claim 56, Wallman discloses wherein the trade advisor component is operative to propose alternative transactions to the proposed transaction of the client based at least in part on the combined ranking for the proposed transaction (column 37, lines 10-28).

Regarding to claim 58, Wallman discloses a system for providing trading advice for a portfolio of securities, the system comprising:

a ranker component operative to receive a request to rank relevant securities (figure 13, items 53a, 55a-55h, 54a, 56a-56h, and column 37, line 58-column 38, line 26; risk ranking and differential return ranking);

a portfolio component in communication with the ranker component and operative to receive a get benchmark request from the ranker component figure 16 and column 39, lines 47-55; portfolio characteristics database 165) and a get tax lots request from the ranker component (column 34, lines 15-35); and

a security analyst component in communication with the ranker component and

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operative to receive a get security rankings request from the ranker component (column 24, lines 1-25);

the ranker component operative to determine risk rankings of relevant securities using portfolio minus benchmark weights in determining the combined rankings of relevant securities based at least in part on risk rankings and on security forecast rankings (figure 13, items 53a, 55a-55h, 54a, 56a-56h, and column 37, line 58-column 38, line 26; risk ranking and differential return ranking; column 16, lines 37-55; column 30, lines 32-60; column 40, lines 40-50; security forecast ranking).

Regarding to claim 60, Wallman discloses wherein the system further comprises: an asset allocator in communication with the ranker component, the asset allocator operative to receive combined rankings for relevant securities from the ranker component and to create a trade list based at least in part on the combined rankings (column 23, lines 21-60; the asset allocation model 1).

Regarding to claim 65, Wallman discloses wherein the asset allocator is operative to receive one of a raise cash value, a spend cash value and a maximum turnover and to pass a rank portfolio request to the ranker component (column 27, lines 38-62).

Regarding to claim 66, Wallman discloses a method for providing trading advice for a portfolio of securities, the method comprising:

receiving portfolio information (column 23, lines 21-40; receiving the investor's risk tolerance, financial goals,, preferred risk-return characteristics, preferences for various types of securities and preferred portfolio mix, etc);

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using a ranker component to pass a get benchmark request to a portfolio component (column 24, lines 1-25);

using a ranker component to pass a get security rankings request to a security analyst component (column 25, line 18-column 26, line 27; the system provides the list of stocks that match the investor's criterion);

determining risk rankings for relevant securities using portfolio minus benchmark weights (figure 5; figure 13 and column 32, lines 58-67; determining risk ranking relative to the benchmark weights S&P 500 or another index);

determining combined rankings for relevant securities based at least in part on risk rankings and on security forecast rankings figure 13, items 53a, 55a-55h, 54a, 56a-56h, and column 37, line 58-column 38, line 26; risk ranking and differential return ranking; column 16, lines 37-55; column 30, lines 32-60; column 40, lines 40-50; security forecast ranking); and

generating an order list based on the combined rankings (figure 13).

Regarding to claim 69, Wallman discloses wherein the ranker component is operative to determine a risk ranking for a relevant security by adding a specified weighting to the portfolio, determining a revised contribution to factor risk and residual risk, subtracting original values, and dividing by a change in weight (column 24, lines 14-17; column 26, lines 10-35; adjusting percentage allocation to meet the investor's financial goals, suggesting changes to the portfolio to satisfy the investor's preference).

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Regarding to claim 71, Wallman discloses wherein the relevant securities comprise a universe of securities including securities held in the portfolio and securities not held in the portfolio (column 37, lines 10-28).

Regarding to claim 72, Wallman discloses wherein obtaining security rankings comprises determining a consensus forecast from a plurality of security analysts (column 16, lines 1-22).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 57, 59, 61-64, 67, 68, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman, U.S. Patent No. 6,601,044.

Regarding to claim 57, Wallman discloses a system for providing trading advice for a portfolio of securities, the system comprising:

a ranker component operative to receive a request to rank relevant securities (figure 13, items 53a, 55a-55h, 54a, 56a-56h, and column 37, line 58-column 38, line 26; risk ranking and differential return ranking);

a portfolio component in communication with the ranker component and operative to receive a get benchmark request (figure 16 and column 39, lines 47-55; portfolio

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characteristics database 165) and a get tax lots request from the ranker component (column 34, lines 15-35);

a security analyst component in communication with the ranker component and operative to receive a get security rankings request from the ranker component (column 24, lines 1-25);

the ranker component operative: to provide risk rankings of relevant securities using portfolio minus benchmark weights in determining a marginal contribution to risk associated with a relevant security (column 24, lines 1-25); to determine tax rankings based in part on tax lot data (column 34, lines 15-35); the ranker component determining a marginal contribution to risk by: adding a specified weighting to the portfolio; determining a revised contribution to factor risk and residual risk; subtracting original values; and dividing by a change in weight (column 24, lines 14-17; column 26, lines 10-35; adjusting percentage allocation to meet the investor's financial goals, suggesting changes to the portfolio to satisfy the investor's preference).

an asset allocator in communication with the ranker component, the asset allocator operative to receive combined rankings for relevant securities from the ranker component and to create a trade list based at least in part on the combined rankings (column 23, lines 21-60; the asset allocation model 1).

Wallman does not disclose determine combined rankings of relevant securities as a weighted sum of risk rankings, security forecast rankings and tax rankings. However, Wallman does disclose determine the risk rankings, security forecast rankings (figure 13, items 53a, 55a-55h, 54a, 56a-56h, and column 37, line 58-column 38, line

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26; risk ranking and differential return ranking; column 16, lines 37-55; column 30, lines 32-60; column 40, lines 40-50; security forecast ranking), and tax rankings (column 34, lines 15-35). Moreover, it is well known in the art to determine a combined ranking as a weighted sum of the other rankings. For example, determining the overall ranking of a student by summing all rankings from different courses, determining the overall ranking of an employee by summing all rankings from different factors, etc. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Wallman's to apply the obvious method of combining rankings for determining combined rankings of relevant securities as a weighted sum of risk rankings, security forecast rankings and tax rankings for the purpose of providing more accuracy and efficiency in ranking securities, thus providing the investor the better advise in making the investment decision to select the securities included in his portfolio based on the combined rankings, in order to satisfy the investor's investment goals.

Regarding to claims 59, 67, Wallman disclose wherein the portfolio component is operative to receive a get tax lots request from the ranker component, wherein the ranker component is operative to determine tax rankings based in part on tax lot data (column 34, lines 15-35). Wallman does not disclose wherein the ranker component is operative to determine the combined rankings of relevant securities as a weighted sum of the risk rankings, the security forecast rankings and the tax rankings (see claim 57 for more details).

Regarding to claims 61, 68, Walman does not disclose wherein the ranker component is operative to determine a risk ranking for a relevant security by

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determining a marginal contribution to risk associated with the relevant security (figure 5; figure 13 and column 32, lines 58-67; determining risk ranking relative to the benchmark weights S&P 500 or another index). Walman does not disclose wherein the ranker component is operative to determine the combined rankings as a weighted sum of the risk rankings and the security forecast rankings (see claim 57 for more details).

Regarding to claim 62, Wallman discloses wherein the ranker component is operative to determine a risk ranking for a relevant security by adding a specified weighting to the portfolio, determining a revised contribution to factor risk and residual risk, subtracting original values, and dividing by a change in weight (column 24, lines 14-17; column 26, lines 10-35; adjusting percentage allocation to meet the investor's financial goals, suggesting changes to the portfolio to satisfy the investor's preference).

Regarding to claims 63, 70, Wallman does not disclose wherein the ranker component is operative to determine a risk ranking for a relevant security by adding about a 0.1% weighting to the portfolio. However, Wallman does disclose adding a specified weighting to the portfolio (column 24, lines 14-17; adjusting percentage allocation to meet the investor's financial goals). Moreover, adding 0.1% weighting to the portfolio is a desired choice, in Wallman the investor allows to adjust the percentage allocation in his portfolio, thus the investor could add a specific weighting such as 0.1% weighting to meet his financial goal. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Wallman's to include the feature above for the purpose of allowing the investor to modify his portfolio in order to meet his financial goals.

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Regarding to claim 64, Wallman discloses wherein the relevant securities comprise a universe of securities including securities held in the portfolio and securities not held in the portfolio (column 37, lines 10-28).

### ***Conclusion***

8. Claims 11, 15-18, 46, 49, 51-54, and 56-72 are rejected.

9. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Rebane (US 6,405,179) discloses a system and method for the optimal allocation of investment funds among a portfolio of investments.

Anderson (US 6,064,985) discloses an automated portfolio management system and method which manage data in a database, and populates the database with data from a data feed off the Internet.

Ray et al. (US 6,018,722) disclose a computer implemented expert securities portfolio investment management system which operates as Registered Investment Advisor.

O'Shaughnessy (US 6,484,151) discloses a system and method for selecting and purchasing stocks via the Internet.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-1113.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

Or faxed to:

(703) 872-9326 (for formal communication intended for entry),

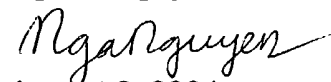
or

(703) 308-3691 (for informal or draft communication, please label

"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen



August 2, 2004